

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Bamas-Jacques, et al.

Examiner: SACKKEY, Ebenezer O.

Application No.: 10/628,093

Art Unit: 1624

Filed: July 25, 2003

Title: Substituted Oxoazaheterocyclyl Compounds

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. 1.705(b)-(d)

Sir:

Responsive to the Determination of Patent Term Adjustment posted on the Patent Application Information Retrieval System (PAIR) as of November 3, 2009, the issue date of U.S. Patent No. 7,612,075 and in light of the recent ruling in *Wyeth v. Dudas*, No. 07-1492, slip op. (D.D.C. Sept. 30, 2008) the Patentees submit this Request for Reconsideration of Patent Term Adjustment under 37 C.F.R. 1.705(b)-(d).

This application is not subject to a terminal disclaimer.

U.S. Patent No. 7,612,075 issued on November 3, 2009. This request is being submitted within two months of the issue date of U.S. Patent No. 7,612,075, and complies with the deadline specified in 37 C.F.R. 1.705(d). In addition, given the recent ruling in *Wyeth*, which was decided on September 30, 2008, the Patentee could not have raised this issue prior to payment of the issue fee. Thus Patentees contend this request is timely.

The data available on PAIR indicates that U.S. Patent No. 7,612,075 has been granted 1162 days of Patent Term Adjustment. Patentees submit that, due to the recent *Wyeth* decision, the correct Patent Term Adjustment should be 1417 days. Patentee, therefore requests that U.S. Patent No. 7,612,075 be granted an additional 255 days of patent term.

Statement of the Facts and Explanation of Calculation

For purposes of this request and in keeping with the explanation provided in *Wyeth*, Patentees will refer to the "A delay" as examination delay under 37 C.F.R. 1.703(a). In the "A delay" the Patent Office delayed prosecution 668 days by issuing the first communication more than 14 months from filing or September 25, 2004 to July 25, 2006 (the beginning of the period of "B delay"); with an additional 413 days of delay up to the mailing of the office action on September 11, 2007 not being counted due to overlap, see below). **Thus the total PTO "A delay" is 668 days.**

Delay due to applicant consists of 35 days in responding to the September 17, 2008 Office Action on January 21, 2009. **Thus total applicants delay is 35 days.**

The Patent Office delayed 784 days by delaying issuance of the patent by more than three years. The period of "B delay" commences on July 25, 2006 (three year anniversary of the filing date) and ends on November 3, 2009 (the issue date of US Patent No. 7,612,075). The Patent Office also delayed prosecution 12 days by not issuing the March 14, 2008 office action within 4 months of receipt of our November 2, 2007 response; an additional 34 days by not issuing the November 17, 2008 office action within 4 months of receipt of our April 14, 2008 response; and 1 day by not issuing the May 22, 2009 Notice of Allowance within 4 months of receipt of our January 21, 2009 response (these additional days of delay are not being counted due to overlap). **Thus the period of "B delay" is 784 days by applicant's calculation.**

Therefore, the Patent Office was responsible for a total of $668 + 784 = 1,452$ days of delay and the applicant is responsible for 35 days of delay. Applicants believe the proper patent term adjustment under *Wyeth* is $1452 - 35 = 1,417$ days.

In light of the foregoing, the Patentees respectfully request that an additional 255 days of Patent Term Adjustment be added to the patent term for Patent Office delay, resulting in a total Patent Term Adjustment of 1417 days.

The Commissioner is authorized to charge the \$200.00 fee set forth in §1.18(e) required by 37 C.F.R. §1.705(b)(1) to Deposit Account No. 18-1982. The Commissioner is also authorized to charge any additional fees required by this paper or credit any overpayment to Deposit Account No. 18-1982.

Respectfully submitted,

Doc. 11,2009



Ronald G. Ort, Reg. No. 26,969
Attorney/Agent for Applicant

sanofi-aventis U.S. LLC
Patent Department
Route #202-206 / P.O. Box 6800
Bridgewater, New Jersey 08807-0800
Telephone: 908-231-2551
Telefax: 908-231-2626
Docket No. USA2575 US CNT1